

REMARKS

1. **Provisional rejection of claims 1-15 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-6, 8-20, 14 and 15 of copending Application Serial No. 09/867,973.**

Applicants appreciate the detailed basis of rejection. However, it is respectfully submitted that a timely filed terminal disclaimer in compliance with 37 CFR 1.321 (c) will render this issue moot. Accordingly, Applicants are in the process of preparing such as disclaimer and will submit an executed disclaimer shortly. A copy of a nonexecuted version of the terminal disclaimer is attached for the Examiner's preliminary review.

2. **Rejection of claims 7-12 under 35 U.S.C. §112, 1st and 2nd paragraphs.**

Claims 7-12 have first been rejected under 35 U.S.C. 112, 1st paragraph as based on a disclosure which is not enabling. The PTO notes that while page 8 of the Specification recites a diameter of from 0.1 to 3 mm for the pellets, claims 7 and 10 set forth a range of from 0.1 to 5 mm for the pellet diameter.

Second, it is the PTO's position that claims 7-12 are indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention. Claims 7-12 are said to fail to recite the apparently essential limitation that the pellets have a diameter of 0.1 to 3 mm. As a result, the claims are said to be indefinite.

Accordingly, it is the PTO's position that claims 7 and 10 are indefinite and not enabled by the disclosure.

Applicants greatly appreciate the detailed basis of rejection but must respectfully disagree. Applicants note as a preliminary matter that the claims as filed are part of the original disclosure. Claims 7 and 10 as originally filed contained the recited ranges of 0.1 to 5 mm for the diameter of the pellets. Applicants have amended the Specification on page 8 to reflect this disclosure. No new matter is incorporated with this amendment in as much as this information was part of the disclosure as originally filed.

In view of the amendment to the Specification, Applicants respectfully submit that claims 7-12 are enabled.

Applicants must also respectfully submit that the claims are not indefinite with respect to the second paragraph of 35 USC 112.

The first sentence of the second paragraph of Section 112 is a requirement for precision and definiteness of claim language. If the scope of subject matter embraced by a claim is clear and if the applicant has not otherwise indicated that he intends the claim to be of a different scope, then the claim particularly points out and distinctly claims the subject matter that the applicant regards as his invention. *In re Borkowski et al.*, 164 U.S.P.Q. 642, (C.C.P.A. 1970).

In this case, the PTO's statement that 'it appears essential that the pellets have a diameter of 0.1 to 3 mm' does not appear anywhere in the Specification. Rather, the sentence relied upon by the PTO on page 8 is part of a larger paragraph that originally stated:

The pellets 18 making up the chemically active filter element 16 are an important feature of the filter 10 hereof. The pellets are made with a diameter in a range of 0.1 to 3 millimeters, preferably in a range of 0.25 to 2 millimeters in order to control the interstitial spaces therebetween in the filter matrix. The size of these interstices is specially chosen and engineered to screen out most complexes which result from a reaction between combustion acids in the filtered oil and the basic conditioner of the pellets, without substantially reducing the flow rate through the chemically active filter member 16.

(Specification, page 8, lines 3-9)

Therefore, while the pellets are an important feature, it is not an essential feature that the diameter be from 0.1 to 3 mm. One of skill in the art reading the complete Specification as originally filed would understand that pellets having a diameter of from 0.1 to 5 mm are within the scope of the claimed invention given the originally disclosed range set forth in claims 7 and 10 as filed. That is, given the range in original claims 7 and 10, one of skill in the art would understand that appropriate interstitial spaces will result from pellets having a diameter in the range of from 0.1 to 5 mm.

Whether a claim is invalid under the second paragraph of Section 112 requires a determination of whether those skilled in the art would understand what is claimed when the claim is read in light of the specification. *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 802 F.2d 1565, 1 U.S.P.Q.2d 1081 (Fed. Cir. 1986). As long as the scope of the claim, when read in light of the specification, is clear to one of ordinary skill in the art, the definiteness requirement has been satisfied. *Slimfold Mfg. Co. v. Kinthead Indus.*, 810 F.2d 1113, 1 U.S.P.Q.2d 1563 (Fed. Cir. 1987).

Accordingly, it is respectfully submitted that claims 7-12 are not indefinite with respect to the 2nd paragraph of 35 USC 112.

Reconsideration and removal of both rejections is respectfully requested.

CONCLUSION

Applicants respectfully submit that the Application and pending claims are patentable in view of the foregoing amendments and/or remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,



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